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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,957	11/17/2003	Jiro Moriyama	CFA00047US	4447

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CANON U.S.A. INC. INTELLECTUAL PROPERTY DIVISION
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EXAMINER	
GARCIA JR, RENE	

ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/715,957	Applicant(s) MORIYAMA ET AL.	
	Examiner Rene Garcia, Jr.	Art Unit 2853	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-9 and 14-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-9 and 14-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 7-9, 14-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silverbrook et al. (US PG PUB 2002/0080396) in view of Tan et al. (US 6,613,403).

Silverbrook et al. disclose the following:

*regarding claims 14, 15, 19 & 23, recording apparatus **/netpage printer, 601/** (fig. 11) and method for forming an image on a recording medium/**netpage, 1/** (fig. 1; paragraph 0216 see also paragraphs 0148 and 0218), comprising:

*recording unit/**print engine controllers, 760/** (fig. 14; paragraph 0554) for performing recording by applying a recording material/**ink/** (paragraph 0243) onto the recording medium/**1/** (fig. 1), the recording unit/**760/** recording the image/**graphic data, 2/** (fig. 1; paragraph 0129) and at least one of a positional information image/**coded data, 3/** representing positional information (paragraph 0158; x & y coordinates) corresponding to the position where the positional information image/**coded data, 3/** is recorded

*control unit/**processor, 750/** (fig. 14; paragraphs 0552 & 0553) for controlling the recording (paragraph 0220) such that the recording unit/**760/** records the positional information image with a recording material/**infrared inks, IR-absorptive black ink/** capable of being detected by a predetermined detector/**netpage pen, 101/** (figs. 8 & 9; paragraph 0255), and

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records the image with another recording material/**inks**/ (paragraph 0243; cyan, magenta, yellow, black) incapable of being detected by the detector/**netpage pen, 101**/ (paragraph 0151 – cyan, magenta, yellow, black are non-infrared emitting)

*wherein the recording material/**infrared inks, IR-absorptive black ink**/ used for recording the positional information image/**coded data, 3**/ contains carbon (paragraphs 0584 – 0592; infrared dyes/**ink**/ contain carbon atoms)

*regarding claims 7, 16, 20, 24, positional information image/**coded data, 3**/ (fig. 1) is expressed by a combination pattern of a plurality of spots to represent the positional information (figs. 6a, 6b & 6c)

*regarding claims 8, 17, 21, 25, positional information/**coded data, 3**/ is associated with coordinates on the recording medium/**netpage, 1**/ (fig. 1; paragraph 0159; x & y coordinates)

*regarding claims 9, 18, 22, 26, positional information/**coded data, 3**/ is associated with coordinates on a virtual plane beyond the area of the recording medium/**netpage, 1**/ (fig. 1; paragraph 0149; multiple pages can have same positional data & each page has unique page ID since recording medium is considered to be one page; paragraph 0157 – region to which a tag [tag ID – positional information] refers can be an arbitrary subregion of a page or other surface [virtual plane])

Silverbrook et al. does not disclose the following claimed limitations:

*regarding claim 14, 15, 19 & 23, recording material used for recording the image is a carbon-free yellow, a carbon-free magenta, a carbon-free cyan and a carbon-free black

*Silverbrook et al. does teach utilize color inks however does not expressly specify which recording material composition to utilize

Tan et al. discloses the following:

*regarding claim 14, 15, 19 & 23, recording material used for recording the image is a carbon-free yellow, a carbon-free magenta, a carbon-free cyan and a carbon-free black (col. 9, lines 10-24, particularly line 20) for the purpose of ink detection and lack of detection based on specific properties (infrared detection).

Silverbrook et al. and Tan et al. are analogous art because they are directed to a similar problem solving area of recording material/**ink**/ detection and recording material lack of detection.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to utilize a recording material used for recording the image is a carbon-free yellow, a carbon-free magenta, a carbon-free cyan and a carbon-free black as taught by Tan et al. into Silverbrook et al. for the purpose of ink detection and lack of detection based on specific properties (infrared detection).

Response to Arguments

3. Applicant's arguments filed 28 March 2007 have been fully considered but they are not persuasive.

In response to arguments on page 12 with respect to claims 14, 15, 19, 23, applicant states Silverbrook (US 2002/0080396) does not describe recording a positional information image, wherein the positional information is recorded on a recording medium. However in paragraphs (0148, and 0218) Silverbrook discloses “The netpage printer receives subscribed netpage documents from netpage publication server 14. Each document is distributed in two parts: the page layouts, and the actual text and image objects which populate the pages.” and;

A netpage consists of a printed page (or other surface region) invisibly tagged with references to an online description of the page. The tags may be printed on or into the surface of the page, may be in or on a sub-layer of the page or may be otherwise incorporated into the page. The online page description is maintained persistently by a netpage page server. The page description describes the visible layout and content of the page, including text, graphics and images. It also describes the input elements on the page, including buttons, hyperlinks, and input fields. The page descriptions of different netpages may share components, such as an image, although the netpages (and the associated page descriptions) are visibly different. The page description for each netpage may include references to these common components. A netpage allows markings made with a netpage pen on its surface to be simultaneously captured and processed by the netpage system.

In Silverbrook application *tags* make up the positional information image claimed in the current application. The *tags* provide information as to the relationship of “actual text and image objects” on the page [when a specified detector/netpage pen/ is used in conjunction with]. See also paragraphs 0150 and 0155.

4. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., page 12 or arguments refers to “arbitrarily recording” of Silverbrook and use of “a translation map”) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). These arguments do not overcome the rejection since the Silverbrook reference discloses the claim limitations as presented.

5. Applicant's arguments on page 13 regarding the use of carbon-free inks has been considered but found persuasive. Silverbrook does not expressly identify a composition of ink to be utilized in the printer, however Tan does specifically point teach at col. 9, lines 10-24 the use of colorant that is free of carbon.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Communication with the USPTO

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rene Garcia, Jr. whose telephone number is (571) 272-5980. The examiner can normally be reached on M-F 8:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen D. Meier can be reached on (571) 272-2149. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Rene Garcia Jr.
05/07


STEPHEN MEIER
SUPERVISORY PATENT EXAMINER